

INTERVIEW SUMMARY AND REMARKS

In the Final Office Action, the Examiner rejected claims 1-11, 15-21, 24-27, 31-35, 37-47, 49-53 and 55-65. Claims 12-14, 21-23, 28-30, 36 and 54 are currently withdrawn from consideration.

On March 14 and 15, 2005, the Applicants representative, Tait R. Swanson (Reg. No. 48, 226), initiated Examiner Interviews to discuss the rejections set forth in the Final Office Action. Regarding the Examiner's rejections under 35 U.S.C. §112, first paragraph, the Applicants emphasized that the claim features of "without active control," "passive," and "without external feedback" are not new matter as suggested by the Examiner, but rather the drawings and detailed description of the present application clearly support embodiments having either active or passive configurations. For example, the Applicants stressed that the drawings illustrate embodiments of a passive system, while the detailed description sets forth other embodiments that also can include a variety of sensors, electronics, computing circuitry, control systems and processors, and various other devices to facilitate control of the system. *See* application, page 5, lines 14-24; page 6, lines 8-16. For these reasons among others, the Examiner agreed that the forgoing claim recitations are supported by the detailed description and the drawings and, thus, are not new matter. The Examiner also agreed to withdraw all outstanding rejections under 35 U.S.C. §112, first paragraph. Regarding the Examiner's rejections under 35 U.S.C. §102, the Applicants stressed that claims 6-9, 24-27, 51-52, and 61-65 were not subject to these prior art rejections and, thus, these claims recite subject matter that is allowable over the prior art. For these reasons, the Examiner agreed that the independent claims 1, 17, 31, 43, and 49 and their respective dependent claims would be allowable based on this claimed subject matter (e.g., intermediate chamber and/or other claim features) if incorporated into the independent claims.

By this paper, Applicants amended independent claims 1, 17, 31, 43, and 49 and dependent claims 4, 5, 7-10, 19, 21, 25, 32, and 52, and cancelled claims 2, 3, 6, 18, 24, 50, and 51. Specifically, the Applicants incorporated the subject matter of dependent claim 6 and intervening claims 2 and 3 into independent claim 1. In addition, the Applicants incorporated the subject matter of dependent claim 24 and intervening claim 18 into independent claim 17. The Applicants also incorporated the subject matter of dependent claim 51 and intervening claim 50 into independent claim 49. Finally, the Applicants incorporated the subject matter of dependent claims 18 and 24 into each of the independent claims 31 and 43 in a similar manner as set forth in the amended independent claim 17. As discussed in further detail below, Applicants stress that the subject matter added to independent claims 1, 17, 31, 43, and 49 was not subject to any prior art rejections in the Final Office Action. In addition, the final independent claim 61 and its dependent claims 62-65 were not subject to any prior art rejections in the Final Office Action. In view of the Examiner Interview, the foregoing amendments, and the following remarks, the Applicants respectfully stress that the pending claims should be in condition for allowance. The Applicants also submit that the withdrawn claims 12-14, 21-23, 28-30, 36 and 54 should be in condition for allowance based on their dependencies from allowable independent claims. Therefore, Applicants respectfully request consideration and allowance of these withdrawn claims along with the other claims.

Objection to the Specification

In the Final Office Action, the Examiner objected to the specification for allegedly failing to provide antecedent basis for the claimed subject matter. Specifically, the Examiner argued that antecedent basis was lacking for “the claim terminology ‘without active control’ in claims 1 and 43, ‘passively fluidly coupled’ in claim 17, ‘without active control between the chambers’ in claim 31, and ‘without external feedback influence’ in

claim 61.” Final Office Action mailed January 28, 2005, page 2. The Applicants respectfully traverse this objection.

As summarized in the foregoing Interview Summary, the Examiner agreed that the above claim terminology is supported by the detailed description and the drawings of the present application. For example, the Applicants reiterate that the drawings of the present application clearly illustrate embodiments of a passive system, while the detailed description sets forth other embodiments that also may or can further include various active control features. As a result, the present application supports embodiments of systems with or without active control or external feedback influence. Examples of this support can be found on page 5, lines 14-24 and page 6, lines 8-16 in the present application. For these reasons, the Applicants stress that the above claim terminology is clearly supported by the specification of the present application. Therefore, the Applicants respectfully request withdrawal of the Examiner’s objection to the specification.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-11, 15-21, 24-27, 31-35, 37-47, 49-53, and 55-65 under 35 U.S.C. §112, First Paragraph, for failing to comply with the written description requirement. The Applicants respectfully traverse this rejection.

Legal Precedent

First, regarding the written description requirement, the initial burden of proof regarding the sufficiency of the written description falls on the Examiner. Accordingly, the Examiner must present evidence or reasons why persons skilled in the art would not recognize a description of the claimed subject matter in the applicant’s disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (CCPA 1976). The Examiner is also

reminded that the written description requirement does not require the claims to recite the same terminology used in the disclosure. The patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff'd.* 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Moreover, any information contained in any part of the application as filed, including the specification, claims and drawings, may be added to other portions of the application without introducing new matter. Accordingly, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985).

Second, regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable? *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *U.S. v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). As long as the specification discloses at least one method for making and using the claimed invention that bears a *reasonable correlation* to the entire scope of the claim, then the enablement requirement of section 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970).

Deficiencies of Rejection

In the Office Action, the Examiner specifically stated:

Claims 1-11, 15-21, 24-27, 31-35, 37-47, 49-53, 55-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In an attempt to define over the prior art of record, the Applicant has amended the claims to include various versions of the negative limitations "without active control", "passive", and "without external feedback". These limitations constitute new matter. There is nowhere in the specification as originally filed that indicates that the piston cylinder arrangements are intended to be passive. In fact, various control sensors are shown, and are disclosed as intended for use in active control (see page 6, 2nd paragraph.) Final Office Action mailed January 28, 2005, Pages 2-3.

Again, as set forth in the Interview Summary above, the Applicants stress that the specification clearly supports the claim recitations of "without active control," "passive," and "without external feedback" and, thus, these rejections should be withdrawn as agreed upon during the Examiner Interviews on March 14 and 15, 2005. Regarding the Examiner's reference to the second paragraph of page 6 in the present application, the Applicants stress that this passage describes an optional control unit, which can be added to the otherwise passive embodiments illustrated in the drawings. For example, the final sentence of this paragraph recites "[t]hese sensors 62 and 64 also can be coupled to a control unit, such as a control unit for the vehicle 10 or for the stabilizer assembly 22." Application, page 6, lines 14-16 (emphasis added). Similarly, the detailed description of the present application recites "[t]he stabilizer assembly 22 also may have a variety of sensors, electronics, computing circuitry, control systems and processors, and various

other devices to facilitate control of the stabilizers 24 and 26.” Application, page 5, lines 17-19 (emphasis added). For these reasons among others, the Applicants reiterate that the forgoing claim recitations are clearly supported by the specification and the drawings and, thus, these claim features are not new matter. As agreed upon during the Examiner Interviews on March 14 and 15, 2005, the Applicants respectfully request withdrawal of these rejections under 35 U.S.C. §112, first paragraph, and allowance of the pending claims.

Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected claims 1-5, 10, 11, 15-21, 31-35, 37-47, 49, 50, and 53-60 under 35 U.S.C. § 102(e) as anticipated by Kincaid et al. (U.S. Patent No. 6,517,094). Applicants respectfully traverse these rejections. However, in view of the amendments set forth above, the Applicants stress that these rejections are moot and should be withdrawn. For example, the Kincaid reference does not teach or suggest an “intermediate chamber” as recited by amended independent claims 1, 17, 31, 43, and 49. Again, as discussed above, these independent claims have been amended based on the subject matter of dependent claims 6, 24, and 51 and their respective intervening claims. The Applicants further stress that dependent claims 6, 24, and 51, among other claims, were not subject to any prior art rejections. For these reasons, the Applicants respectfully request withdrawal of the foregoing rejections under 35 U.S.C. § 102(e) and allowance of all pending claims, including the previously withdrawn claims.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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